

REMARKS

In response to the Final Office Action mailed August 8, 2003, Applicant respectfully requests entry of this response and reconsideration of the claims pending. By this amendment, Applicant has amended claim 12. Claims 2, 5 and 7-17 are pending for examination with claims 1 and 12 being independent claims. No new matter has been added by this amendment.

A. Submission of Supplemental ADS

Applicant submits herewith a supplemental ADS correcting the attorney's docket number and, adding a correct correspondence and representative customer number and adding domestic priority information. Entry of this supplemental ADS is respectfully requested.

B. Rejection Under 35 U.S.C.

Claim 12 stands rejected under 35 U.S.C. §102(b) as being anticipated by Barnett, U.S. Patent No. 5,704,479. Applicant has amended claim 12 to further distinguish over the art of record.

Barnett discloses a box for storing and dispensing wire and the like, including an insert 28 that fits inside the box (see FIG. 1). The insert 28 comprises an inner wall having a journal 48 for supporting a spool 26, 34. The insert 28 is formed of a separate sheet of stock from the sheet of stock of which the box is formed, and is not integral with the box.

Applicant's claim 12, as amended, recites, *inter alia* "the box comprising an inner side wall integrally formed within the box of the single sheet of stock, the inner side wall defining a journal for supporting the spool." As discussed above, Barnett discloses an insert that is formed of a separate sheet of stock from that of which the box is formed to support the spool. However, Barnett does not disclose that an inner side wall integrally formed within the box of the single sheet of stock, i.e., of the sheet of stock already identified as that of which the box is formed, is formed to support the spool that is located within the box. The insert disclosed in Barnett supports the spool, but is not integral with the stock from which the balance of the box is formed. Because Barnett does not disclose a "box comprising an inner side wall integrally formed within the box of the single sheet of stock, the inner side wall defining a journal for supporting the

spool,” as is recited in Applicant’s claim 12, as amended, Barnett does not anticipate Applicant’s claim 12. Accordingly, withdrawal of this rejection is respectfully requested.

B. Rejections Under 35 U.S.C. §103

Claims 2, 5, 7, 8 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barnett in view of Gaffney, U.S. Patent No. 4,382,510 and Mason, U.S. Patent No. 4,417,660. Applicant has amended claims 2 and 12 to further distinguish over the art of record.

The Examiner, in the Office Action, states that Barnett discloses a box (30) formed from a single sheet of cardboard for dispensing a length of cable (24) wound around a spool (22,26) comprising at least six walls...an opening (70) in one of the walls, a cable spool support (28) located in the box including a pair of rigid supports...shaped to support opposite ends of a spindle and each of the supports including a journal (82, 84) integrally formed in the support. The Examiner acknowledges that Barnett does not disclose a “panel in one of the walls of the box adapted to be displaced to provide the opening and the pair of rigid supports being integrally formed of the single sheet of cardboard.” The Examiner asserts that Gaffney shows a box for dispensing a web, the box including a plurality of walls, one of the walls including a panel (30) adapted to be displaced to provide an opening for dispensing the web. The Examiner further states that Mason discloses a shipping carton (for lampshades) having an anchoring flap means integrally formed from the same sheet of the carton to eliminate the need for separate inserts. The Examiner asserts that “it would have been obvious...to modify the box of Barnett to include a panel adapted to be displaced to provide the opening to prevent dust etc. from getting into the box during storage (as taught by Gaffney) and so that the pair of rigid supports is integrally formed of the sheet of cardboard to reduce costs of manufacture, as taught by Mason.”

Applicant respectfully disagrees.

Applicant’s claim 2 recites “a cable spool support integrally formed within the box of the single sheet of stock, the support including journals to rotatably support a spindle of a spool of cable for dispensing cable.” Thus, the claimed subject matter includes the support integrally formed within the box of the single sheet of stock and further that the support include journals “to rotatably support a spindle of a spool of cable for dispensing cable.” Not only must the support be integral with the rest of the box, but the support must be strong enough “to rotatably

support a spindle of a spool of cable for dispensing cable." The Examiner's proposed combination is both unmotivated and fails to teach the invention even if motivated because there is no teaching of this combination of features.

To make a *prima facie* case of obviousness, and to sustain a rejection under 35 U.S.C. § 103, the Examiner must point to some objective teaching in the prior art of record that suggests the asserted combination and/or modification. In this case, there is no motivation to combine Mason with the other references because lampshades have substantially different shipping requirements than spools of wire. Moreover, even if the combination were made, the references do not teach or suggest making a sufficiently strong integral support for dispensing cable from a spool.

Mason is directed to a shipping carton for storing and transporting lamp shades. According to Mason, in order to package a lamp shade in a conventional carton, the practice has been to use separate inserts located adjacent the top and bottom walls of the completed carton. Mason discloses a shipping carton including anchoring flap means 11 (see Fig. 1) that are provided in the top wall end flap 29 and bottom wall end flap 28. According to Mason, end flaps 28 and 29 having medial flaps 36, 52 respectively formed therein, which are adapted to cooperate to provide the integral, anchoring flap means 11. Mason discloses that the integral flap means 11 aligns a semi-circular passageway 33a and an aperture 56 that is selected to register with an aperture 46 formed in the washer fitting 47 of a typical lamp shade, as illustrated in Fig. 2. Mason's design is fairly complex and specific to supporting a lampshade, a relatively lightweight object within the carton. Mason makes absolutely no mention of supporting heavier objects, or of dispensing cable. Indeed, the complex arrangement of flaps disclosed would be incapable of rotatably supporting a spool of cable for dispensing. On this basis alone, the skilled designer would not have referred to Mason for assistance in designing the support required for dispensing wire from a spool within a box.

While Barnett shows a support capable of supporting a spool of cable for dispensing, the arrangement of panels of the support are incompatible with the arrangement of the flaps of Mason. Barnett calls for a separate insert specifically in order to achieve the strength required, stating that the insert is a preferred design and the insert includes support flaps to "improve the support strength of the insert," thus teaching away from a combination with Mason. In order to

apply the teachings of Mason to Barnett, one would end up with a box whose support was too weak to support a spool of cable for dispensing. Indeed, there is no explanation in either reference of how to obtain the combination of strength and unity of design required by the claim language. Therefore, there is no teaching or suggestion that would be understood by the skilled artisan of how to combine Mason and Barnett to achieve, "a cable spool support integrally formed within the box of the single sheet of stock, the support including journals to rotatably support a spindle of a spool of cable for dispensing cable," as recited by claim 2. Accordingly, withdrawal of the rejection of claim 2 is respectfully requested.

Claims 5, 7 and 8 each depend ultimately from claim 2 and are therefore allowable for at least the same reasons as discussed above in connection with claim 2. Accordingly, withdrawal of the rejection of claims 5, 7 and 8 is also respectfully requested.

Claim 12, similarly to claim 2 recites "a box formed of a single sheet of stock, for dispensing cable from a spool having spool side walls, the box comprising an inner side wall integrally formed within the box of the single sheet of stock, the inner side wall defining a journal for supporting the spool." In view of this recitation and the above discussion of claim 2, the combination of Barnett, Gaffney and Mason is improperly applied to claim 12 for the same reasons as discussed above in connection with claim 2. Applicant therefore also respectfully requests that the rejection of claim 12 be withdrawn.

Claims 13-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Barnett, Gaffney and Mason as applied to claim 12 above and in further view of Official Notice taken of the fact that it is old and conventional practice to provide a score line to facilitate bending of a portion of a box wall. Applicant respectfully traverses this rejection.

Each of dependent claims 13 – 16 depend from claim 12. Accordingly, withdrawal of this rejection is respectfully requested for at least the same reasons as discussed above in connection with the rejection of claim 12 over the combination of Barnett, Gaffney and Mason. Moreover, the examiner has not identified any reference or combination of references, nor taken Official Notice with respect to any of the features specifically added by claims 14 – 16. Therefore, claims 14 – 16 are additionally allowable at least for reciting novel and non-obvious features not disclosed or taught by any of the cited art.

D. Allowable Subject Matter

Applicant notes with appreciation that claims 9-11 and 17 are indicated as containing allowable subject matter. The Examiner objects to these claims as being dependent upon a rejected base claim. In view of the arguments in support of patentability of the independent claims presented above, and the amendments to independent claim 12, Applicant believes that claims 9-11 and 17 now depend from allowable claims. Therefore, withdrawal of this objection is respectfully requested.

E. Conclusion

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50/2762.

Respectfully submitted,
Gerard Cote, Applicant

By: 

Gary S. Engelson, Esq. (Reg. No. 35,128)
LOWRIE, LANDO & ANASTASI, LLP
Riverfront Office Park
One Main Street
Cambridge, MA 02142
United States of America
Telephone: (617) 395-7015
Facsimile: (617) 395-7070

Dated: December 4, 2003
Attorney Docket No.: N0349-7214